

## **REMARKS**

Per the final office action dated January 29, 2008, claims 1, 2, 4, 5, 7, 8, 11-23 and 26-28 were pending prior to this amendment. Claims 1, 2, 11, 12, 16, 17, 26, and 28 are allowed. Claims 4, 5, 7, 8, 12-15 and 18-23 are rejected. Per the Advisory Action dated April 17, 2008, specifically items 3 and 7, the amendments requested by applicant by way of a 37 C.F.R. 1.116 amendment on March 28, 2008, have been rejected and none such amendments have been entered into the record. Applicant responds now to the January 29, 2008, final office action. Claims 1, 4, 7, 8, 11-14, 17, 22, 26 and 28 have been amended. Claims 15, 21, 23, and 27 have been cancelled. New claims 29 and 30 have been added. Applicant now requests reconsideration and allowance of the application.

### **Allowed claims**

Claims 1, 2, 11, 12, 16, 17, 26, and 28 are allowed. Although the applicant's attorney agrees with the Examiner's conclusion that these claims are allowable, the applicant's attorney notes that the claims may be allowable for reasons other than those identified by the Examiner and does not concede that the Examiner's characterizations of the terms of the claims and the prior art are correct.

Regarding allowed claim 12, Applicant notes that the Office Action rejected allowed claim 12 based on 35 U.S.C. § 103 (claim 12 was indicated as both allowed and rejected per the Office Action summary on page 2 of the Office Action). As will be explained later in greater detail, although Applicant does not concede any basis for rejecting allowed claim 12, in the interest of expediting prosecution claim 12 has been amended.

### **Claim Rejections - 35 U.S.C. § 112**

Claims 15, 21, and 23 were rejected under 35 U.S.C. § 112, first paragraph, based on written description and enablement.

The standard for written description is whether the patent specification describes the claimed invention such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See* MPEP 2163, paragraph I. Here, the specification shows that Applicant was in possession of sensing vibration in any direction as at least expressly

shown in at least FIG. 4, block 402, and as at least expressly described in at least paragraph 16. Applicant was also in possession of compensating for the same as at least expressly shown in at least FIGS. 4 and 5, blocks 404, 408, and 414, and as at least expressly described in at least paragraphs 16 and 17. Thus, the features of claims 15, 21, and 23 are disclosed and do not constitute new matter.

Regarding the enablement rejection of claims 15, 21, and 23, this rejection is improper for at least the reason that the Office has not met its initial burden for establishing an enablement rejection. The standard for enablement is whether undue experimentation is needed to practice the claimed invention. *See* MPEP 2164.01 citing *In re Wands*, 8 USPQ2d 1400, 1404. The Examiner must determine the question of law based on factual findings and “should **never** make the determination based on personal opinion.” MPEP 2164.05 (emphasis in the original). Here, the Office Action jumps to a legal determination without making any factual findings supporting the legal determination. For example, although the Office Action lists some Wands factors that allegedly support a legal determination of non-enablement, the Office Action does not provide any factual findings indicating why the Examiner believes that the listed factors support non-enablement instead of enablement. Moreover, the Examiner’s personal opinion that “it is infinitely harder to optically correct an image for vibration in each of the X, Y, and Z directions at the same time” does not appear to be based on any evidence and therefore is not a factual finding. Accordingly, since the Office Action makes a legal determination unsupported by any factual findings, the Office has not met its initial burden of establishing an enablement rejection.

However, despite the rejections to claims 15, 21, and 23 being improper for at least the reasons explained above, in the interest of expediting prosecution Applicant has cancelled claims 15, 21, and 23.

Claim 27 was rejected under 35 U.S.C. § 112, first paragraph, based on written description.

Applicant does not concede any basis for the written description rejection of claim 27. However, in the interest of expediting prosecution, claim 27 has been cancelled.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 4, 5, 7, 8, 12-14, 18-20, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paltz, *et al.*, (European Publ. No. 0003243 A1) in view of Misawa, *et al.*, (U.S. Patent No. 5,041,852) and further in view of Ariga, *et al.*, (U.S. Patent No. 5,933,191).

Applicant traverses the obviousness rejection for similar reasons as stated previously on the record; however, in the interest of expediting prosecution, claims 4, 7, and 12 have been amended. Given the Examiner's reasons for allowing claim 1, it is believed amended claims 4, 7, and 12 are allowable for at least similar reasons that claim 1 was allowed. Claims 5, 8, 13, 14, 18-20, and 22, being dependent, include the same features as their respective base claims and thus should be allowed for at least the same reasons. New claims 29 and 30, being dependent, include the same features as their base claim and thus should be allowed for at least the same reasons.

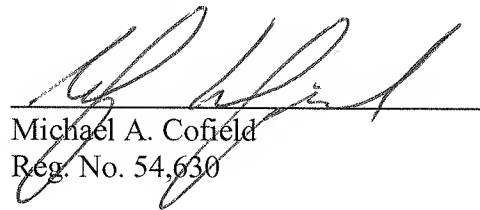
### **Conclusion**

For the foregoing reasons, reconsideration and allowance of the application as amended is requested. The examiner is encouraged to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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